

Appl. No. 10/068,401
Amdt. Dated April 4, 2006
Reply to Office Action of February 2, 2006

Docket No. CM04288H
Customer No. 22917

REMARKS/ARGUMENTS

Claims 1-3 and 5-46 are pending in this office action. Claims 1-3, 5-7, 10-15, 17-22, 25-35 and 37-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Harif (US 2002/0133716). Claims 8, 9, 16, 23, 36 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harif (US 2002/0133716) in view of Menezes, et al. ("Handbook of Applied Cryptography," CRC Press LLC, 1997, pages 397-404 & 493-495).

Applicants appreciate the time that the Examiner spent to conduct a telephone interview on 3 April 2006, since the interview was helpful in allowing the Applicants to explain that Harif is an improper basis for rejecting Applicants claims. As such, Applicants understood the Examiner to state that Applicants' claims have been improperly rejected and that the final rejection dated 2 February 2006 will be withdrawn. Applicants note that the Examiner stated that Applicants' amendment necessitated the new ground of rejection when a new ground of rejection was not presented. Office Action, page 9. As such, Applicants assert that the Examiner improperly marked the Office Action dated 2 February 2006 as final and look forward to the withdrawal of the final action.

As is known to the Examiner, MPEP § 2131 provides that

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim

Regarding Claims 1, 17, 27-29, the Examiner asserts that Harif teaches a method/apparatus for authenticating an entity in a vehicle. In the Office Action dated 2 February 2006, the Examiner outlines the following elements as being found in Harif.

| Examiner's Comments | Examiner's Reference to Harif |
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| A first, trusted entity residing in the vehicle | fig. 1, ref. num 14 |
| A second entity residing in the vehicle and in communication with the trusted entity | fig. 1, ref. num 18 |
| Wherein the trusted entity receives a service request, determines whether the second | fig. 6, ref. num 106, 108 and paragraph 0049 |

Appl. No. 10/088,401
 Amdt. Dated April 4, 2006
 Reply to Office Action of February 2, 2006

Docket No. CM04288H
 Customer No. 22917

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| entity is an authentic entity in response to the service request, and when the second entity is not an authenticated entity, authenticates the second entity to produce an authenticated entity and grants the service request | |
| Wherein the trusted entity is a vehicle gateway | paragraph 0057, the primary encoding device is a trusted source within the vehicle |
| Wherein the second entity is one of a wireless gateway, vehicle system, and a user system | paragraph 0058, programmable key is used in a vehicle system to perform a variety of tasks |

It is noted that the Examiner's reliance upon Harif appears to be misplaced. As such, Applicants traverse the Examiner's rejection of the claims.

As can be seen from the above table, the Examiner has equated Harif's primary encoding device 14 with Applicants' trusted gateway and Harif's programmable key 18 with Applicants' entity. Even though such an equation is faulty for a number of reasons, e.g. the terms trusted gateway and entity are not defined as in Harif. In interpreting pending claim terms, the Examiner is reminded that MPEP § 2111 requires that pending claims be given their broadest reasonable interpretation *consistent* with the specification. As such, the Examiner is asked to refer to Applicants specification for interpreting pending claim terms trusted gateway and entity. In any case, both the trusted gateway and the entity must be in a vehicle as claimed in Applicants' claims.

Assuming that an argument can be made that Harif's primary encoding device 14 can be equated with Applicants' trusted gateway and Harif's programmable key 18 can be equated with Applicants' entity, even though Applicants' argue in the above paragraph that such an argument can not be made, Applicants' henceforth respond to the other aspects of the Examiner's Office Action.

The Examiner asserts that in Harif, the first, trusted entity resides in a vehicle. Office Action, page 2. This is incorrect. In contrast, Harif's primary encoding device 14, which the Examiner has equated to a first, trusted entity, resides, e.g. at a retail dealership, rental dealership, and company fleet. See Harif, paragraph 57. Applicants claims require *a trusted*

Appl. No. 10/068,401
Amdt. Dated April 4, 2006
Reply to Office Action of February 2, 2006

Docket No. CM04288H
Customer No. 22917

gateway residing in a vehicle and such a limitation is not described by Harif as required by MPEP § 2131.

The Examiner further asserts that in Harif, the second entity resides in a vehicle. Office Action, page 2. This is incorrect. In contrast, Harif's programmable key 18, which the Examiner has equated to an entity, is separate from the vehicle and is being programmed for use with the vehicle. See Harif, paragraph 58. In any case, the programmable key 18 is not in the vehicle. Applicants claims require *an entity* and such a limitation is not described by Harif as required by MPEP § 2131.

The Examiner further asserts that in Harif, the trusted entity receives a service request, determines whether the second entity is an authentic entity in response to the service request, and when the second entity is not an authenticated entity, authenticates the second entity to produce an authenticated entity and grants the service request. This is incorrect. In contrast, Harif teaches that an ASP 10 authenticates the primary encoding device 14, not whether the programmable key 18 can be authenticated as stated by the Examiner. See Harif, Fig. 6, step 106. Applicants claims require *that the trusted gateway determine whether the entity is an authenticated entity and when the entity is not an authenticated entity, authenticating the entity to produce an authenticated entity* and such a limitation is not described by Harif as required by MPEP § 2131.

The Examiner further asserts that the second entity is one of a wireless gateway, vehicle system, and a user system. This is incorrect. In contrast, Harif teaches that the programmable key, which the Examiner has equated to Applicants' entity, is distributed to users of a vehicle and may be used to operate the vehicle. See Harif, paragraph 58. How can one of a wireless gateway, vehicle system, and a user system be distributed to users of a vehicle and used to operate a vehicle? Applicants claims require *an entity wherein the entity is at least one of a wireless gateway, a vehicle system, and a user system* and such a limitation is not described by Harif as required by MPEP § 2131.

Appl. No. 10/068,401
Amdt. Dated April 4, 2008
Reply to Office Action of February 2, 2008

Docket No. CM04288H
Customer No. 22917

For the reason set forth above, Applicants submit that the Examiner has incorrectly rejected Claims 1-3, 5-7, 10-15, 17-22, 25-35 and 37-46 under 35 U.S.C. § 102(e) and respectfully request that the Examiner withdraw the rejection.

Notwithstanding the lack of teaching by Harif of Applicants' claimed invention, as mentioned above, the Harif/Menezes combination also fails as a proper basis of Applicants' claims.

MPEP § 2141.03 requires:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As mentioned above, Harif fails to teach or suggest a number of claim limitations, namely *a trusted gateway residing in a vehicle, that the trusted gateway determine whether the entity is an authenticated entity and when the entity is not an authenticated entity, authenticating the entity to produce an authenticated entity, and the entity, wherein the entity is at least one of a wireless gateway, a vehicle system, and a user system.* Since such limitations are not taught or suggested by Harif, as required by MPEP § 2141.03, Harif in combination with Menezes fails as a proper basis for rejecting Applicants' claims. Thus, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

For the reasons set forth above, Applicants submit that the Examiner has incorrectly rejected Applicants Claims 8, 9, 16, 23, 36 and 44 and respectfully request the withdrawal of the rejection.

Appl. No. 10/068,401
Amdt. Dated April 4, 2006
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Docket No. CM04288H
Customer No. 22917

The Applicants believe that the subject application, as amended in Applicants 29 November 2005 amendment, is in condition for allowance. Such action is earnestly solicited by the Applicants.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
1303 East Algonquin Road
IL01/3rd Floor
Schaumburg, IL 60196
Customer Number: 22917

By: 

Indira Saladi
Attorney of Record
Reg. No.: 45,759

Telephone: 847-576-6735
Fax No.: 847-576-0721

Attachments